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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEROME PEYRELEVADE,
ARNOLD POUTEAU, and
DOMINIQUE BURGARD

Appeal 2009-004490
Application 10/024,352
Technology Center 3600

Decided: March 17, 2010

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Jerome Peyrelevade et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-18, 2-34, 36, and 38. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE and enter a new grounds of rejection pursuant to 37 C.F.R. 41.50(b).¹

THE INVENTION

This invention is a system and method that employs “a module for use in constructing the first and second websites, such that, using the same module, the first and second websites may incorporate common information while each incorporating information unique to each website. In this way, a brand owner might construct a single module that may be used in the websites of multiple resellers. A single change to the module might then simultaneously update multiple reseller websites.” Specification [006].

Claim 17, reproduced below, is illustrative of the subject matter on appeal.

17. A method for enabling components of a supplier's website to be integrated into a website of a reseller, the method comprising:

¹ Our decision will make reference to the Appellants' Appeal Brief (“App. Br.”, filed Jan. 8, 2008) and Reply Brief (“Reply Br.”, filed Sep. 30, 2008), and the Examiner's Answer (“Answer,” mailed Aug. 1, 2008).

enabling alternative functionality in the supplier's web site and in the reseller's website using at least one common module containing a first set of information for incorporation into the supplier's website, an alternative second set of information for incorporation into the reseller's website, and a third set of common information for incorporation into both the supplier's and the reseller's website, wherein the alternative functionality includes displaying identifying information unique to each of the supplier and the reseller, the first set of information including identifying information relating to a product supplied by the supplier and unique to the supplier, and the second set of information including identifying information relating to the product supplied by the supplier and unique to the reseller;

enabling assignment of at least first and second addresses to the module, such that when the module is called in the supplier's website by the first address, the first and third sets of information are caused to be incorporated into the supplier's web site while the second set of information is prevented from being incorporated into the supplier's website, and when the module is called in the reseller's web site by the second address, the second and third sets of information are caused to be incorporated into the reseller's website while the first set of information is prevented from being incorporated into the reseller's website and

making the module available for use in constructing the supplier's and reseller's web sites, such that, using the same module, the supplier and the reseller web sites may incorporate common information while at the same time being customized..

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Call	US 5,913,210	Jun. 15, 1999
Tobin	US 6,141,666	Oct. 31, 2000

The following rejections are before us for review:

1. Claims 17, 18, 25-27, 34, 36, and 38 are rejected under 35 U.S.C. §102(b) as being anticipated by Call.
2. Claims 17, 18, 25-27, 34, 36, and 38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Call and Tobin.

ISSUES

The first issue is whether claims 17, 18, 25-27, 34, 36, and 38 are anticipated under 35 U.S.C. §102(b) by Call. Specifically, the issue is whether Call describes the method of claim 17.

The second issue is whether claims 17, 18, 25-27, 34, 36, and 38 are obvious under 35 U.S.C. §103(a) by Call and Tobin. Specifically, the issue is whether one of ordinary skill in the art would have been led by Call and Tobin to the method of claim 17.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v.*

Quigg, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

The scope and content of the prior art

Call

1. Call describes a system that uses an “Internet resource called a product code translator for storing cross-references between universal product codes [UPC] identifying specific products and Internet addresses specifying the locations at which information about these products may be obtained.” Call: Col. 1, ll. 37-41.
2. Call describes the functions of the product code translator as accepting cross-references submitted by manufacturers and accepting queries via the Internet containing a UPC and returning an Internet address where product information can be found. Call: Col. 1, ll. 48-60.
3. Call describes manufacturers having website that contain information about their products (Call: col. 8, ll. 11-15), including product description records which may be downloaded by a reseller (*See* Call: col. 10, ll. 44-56).
4. Call states:

The ISP 111 hosts a website for each reseller served in conventional fashion, typically using a domain name assigned to the reseller. The ISP further makes available online merchant software which enables customers to search the reseller's website for products of interest, and view lists of products resulting from each search. . . . Using the present invention, products listings presented to

customers by these online merchant software systems may be enhanced with links to detailed information about any product of interest made available by participating manufacturers. The searchable product database used by the ISP 111 may be built, as described above, using the universal product codes supplied by the retailer to access the structured data files made available by the participating manufacturers . . . at the IP-addresses supplied by the product code translator..

Call: Col. 12, 1. 54 – col. 13, 1. 5.

Tobin

5. The Examiner cited Tobin, in the rejection, to teach unique identifying information on web-sites in order to promote branding.
Answer 5.

Any differences between the claimed subject matter and the prior art

6. Call does not describe the product code translator having the first, second and third sets of information as recited in claim 17.
7. Call does not describe that the product code translator is assigned first or second addresses such that the information from the module is incorporated to the supplier's or reseller's website as claimed

The level of skill in the art

8. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent art of electronic commerce. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate

level and a need for testimony is not shown'") (Quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Secondary considerations

9. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Obviousness

Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 550 U.S. at 407 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.") The Court in *Graham* further noted that evidence of

secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Graham*, 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 17, 18, 25-27, 34, 36, and 38 under §102(e) as being anticipated by Call.

Claims 17 and 18

The Appellants argue that the product code translator of Call is not the claimed common module, because the product code translator does not contain the claimed first, second, and third sets of information for incorporation into supplier’s or reseller’s websites but instead only contains information that cross-references a UPC code to a manufacturers website.

App. Br. 13-16. Further, the Appellants argue that the product code translator does not have a first and second address that function such that calling the module with either the first or second address causes the sets of information to be incorporated into the supplier’s or reseller’s website in the manner recited in claim 17. App. Br. 16-18.

In the rejection, the Examiner equates the claimed module to the product code translator (Answer 4), but does not respond to the Appellants’ arguments in the Appeal Brief. The Examiner states that “[t]he examiner believes that the 35 USC 103 rejection is much stronger and will address these argument starting on page 24.” Answer 9.

“Invalidity on the ground of ‘anticipation’ requires lack of novelty of the invention as claimed. . . . that is, all of the elements and limitations of the claim must be shown in a single prior reference, arranged as in the claim.”

Karsten Manufacturing Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1383 (Fed. Cir. 2001)

We agree with the Appellants that method claim 17 is not anticipated by Call. Claim 17 recites a step of enabling alternative functionality in the supplier's web site and in the reseller's website using at least one common module. Claim 17 requires that the common module having "a first set of information for incorporation into the supplier's website" and that the first set of information includes "identifying information relating to a product supplied by the supplier and unique to the supplier." Claim 17 also recites the common module having "an alternative second set of information for incorporation into the reseller's website" and that the second set of information includes "identifying information relating to the product supplied by the supplier and unique to the reseller." Claim 17

The product code module of Call does not contain the first and second sets of information. FF 6. Call's product code module contains a database that contain UPC codes and a corresponding IP-addresses for a manufacturer's product website. FF 1. This information is not unique to the reseller.

Further, claim 17 recites "a step of enabling assignment of at least first and second addresses to the module, such that" appropriate sets of the information are incorporated or prevented from being incorporated into the supplier's or reseller's website. Call does not describe that the product code translator is assigned first or second addresses such that the information from the module is incorporated into the supplier's or reseller's website as claimed. FF 7. While Call does describe incorporating information from the manufacturer's website to the reseller's website (FF 3-4), Call does not

describe incorporating the information from the product code translator into the reseller's website, but merely describes the product code translator returning the manufacturer's website's IP-address in response to a query. FF 2.

Accordingly, we find that the Appellants have overcome the prima facie showing of anticipation as to the rejection of claim 17, and claim 18, dependent thereon, under 35 U.S.C. § 102(b) as anticipated by Call.

Claim 25 and 34

Claim 25 recites a system having means for performing the steps recited in claim 17. To traverse the rejection of claim 25, the Appellants argue that this claim contains limitations similar to claim 17 and rely upon the arguments made with respect to claim 17. App. Br. 19-20. Again, we note that the Examiner does not respond to these arguments. Answer 9.

35 U.S.C. 112, sixth paragraph: “An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” (emphasis added)).

In the Appeal Brief, the Appellants provide citations to the corresponding structure in the Specification for the claimed means. App. Br. 7-8. These citations equate the means to a processor programmed to perform the claimed functions. *See* App. Br. 7-8 and Specification [0038] - [0042]. For the reasons given above, we find that Call does not describe a processor performing the claimed functions or an equivalent. Accordingly,

we find that the Appellants have overcome the prima facie showing of anticipation as to the rejection of claim 25, and claim 34, dependent thereon, under 35 U.S.C. § 102(b) as anticipated by Call.

Claim 26 and 36

Claim 26 recites a system having code for performing the steps recited in claim 17. To traverse the rejection of independent claim 26, the Appellants argue that this claim contains limitations similar to claim 17 and rely upon the arguments made with respect to claim 17. App. Br. 20-21. Again, we note that the Examiner does not respond to these arguments. Answer 9. For the reasons given above, we find that Call does not describe code for performing the claimed functions. Accordingly, we find that the Appellants have overcome the prima facie showing of anticipation as to the rejection of claim 26, and claim 36, dependent thereon, under 35 U.S.C. § 102(b) as anticipated by Call.

Claim 27 and 38

Claim 27 recites a computer program product having code for performing the steps recited in claim 17. To traverse the rejection of claim 27, the Appellants argue that this claim contains limitations similar to claim 17 and rely upon the arguments made with respect to claim 17. App. Br. 21-22. Again, we note that the Examiner does not respond to these arguments. Answer 9. For the reasons given above, we find that Call does not describe code for performing the claimed functions. Accordingly, we find that the Appellants have overcome the prima facie showing of anticipation as to the

rejection of claim 27, and claim 38, dependent thereon, under 35 U.S.C. § 102(b) as anticipated by Call.

The rejection of claims 17, 18, 25-27, 34, 36, and 38 under §103(a) as being unpatentable over Call and Tobin.

Claims 17 and 18

In the rejection², the Examiner relies upon the interpretation of Call presented in the rejection under § 102(b) and asserts that “Call shows all of the limitations of the claims except for specifying unique identifying information, a label, on the manufacturer’s and reseller’s web-sites.”

Answer 5. The Examiner then supplies Tobin to teach providing unique identifying information on web sites in order to promote branding. Answer 5.

The Appellants rely upon their arguments made with respect to the rejection under 35 U.S.C. § 102(b) to assert that Call does not teach all of the limitations of the independent claim 17. Answer 24. Further, the Appellants argue that Tobin does not cure the deficiencies of Call (App. Br. 25-26) and does not teach unique identifying information on web-sites but

² We note that on page 7 of the Examiner’s Answer, the Examiner for the first time supplies a mapping of the steps of claim 17 to the prior art. This claim mapping provides an interpretation of Call and Tobin, which was not presented in the rejection. For example, in the rejection the Examiner equates the claimed module to Call’s product code translator (Answer 5) but in the claim mapping the Examiner equates the claimed module to Call’s product code translator plus the manufacturer’s website server and reseller’s website and Tobin’s supplier’s website and reseller’s website. We will address the rejection made by the Examiner in the Final Rejection of September 8, 2007 and restated in the Examiner’s Answer on pages 3-5.

only teaches different documents having different logos from the same website (Reply. Br. 4-5).

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR.*, 550 U.S. 398, 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

As discussed above with regards to the rejection under 35 U.S.C. § 102(b), we find that Call’s product code translator, cited by the Examiner, does not teach the claimed common module. In the rejection, the Examiner does not rely upon Tobin to teach the claimed common module or provide any explanation as to whether the claimed common module would be within the general knowledge of one of ordinary skill in the art. Answer 5.

Accordingly, we find that the Appellants have overcome the prima facie showing of obviousness as to the rejection of claim 17, and claim 18, dependent thereon, under 35 U.S.C. § 103(a) as unpatentable over Call and Tobin.

Claims 25 and 34

Claim 25 recites a system having means for performing the steps recited in claim 17. To traverse the rejection of claim 25, the Appellants argue that this claim contains limitations similar to claim 17 and rely upon the arguments made with respect to claim 17. App. Br. 25-26.

For the reasons given above, we find that Call does not teach the claimed means for enabling alternative functionality using a common module. In the rejection, the Examiner does not rely upon Tobin to teach the

claimed means or provide any explanation as to whether the claimed means would be within the general knowledge of one of ordinary skill in the art.

Answer 5. Accordingly, we find that the Appellants have overcome the prima facie showing of obviousness as to the rejection of claim 25, and claim 34, dependent thereon, under 35 U.S.C. § 103(a) as unpatentable over Call and Tobin.

Claim 26 and 36

Claim 26 recites a system having code for performing the steps recited in claim 17. To traverse the rejection of independent claim 26, the Appellants argue that this claim contains limitations similar to claim 17 and rely upon the arguments made with respect to claim 17. App. Br. 27-28. For the reasons given above, we find that Call does not teach the claimed code for performing the claimed functions. Accordingly, we find that the Appellants have overcome the prima facie showing of obviousness as to the rejection of claim 26, and claim 36, dependent thereon, under 35 U.S.C. § 103(a) as unpatentable over Call and Tobin.

Claim 27 and 38

Claim 27 recites a computer program product having code for performing the steps recited in claim 17. To traverse the rejection of claim 27, the Appellants argue that this claim contains limitations similar to claim 17 and rely upon the arguments made with respect to claim 17. App. Br. 28-29. For the reasons given above, we find that Call does not describe code for performing the claimed functions. Accordingly, we find that the Appellants have overcome the prima facie showing of obviousness as to the

rejection of claim 27, and claim 38, dependent thereon, under 35 U.S.C. § 103(b) as unpatentable over Call and Tobin.

NEW GROUND OF REJECTION

Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection of claims 27 and 38. We reject claims 27 and 38 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claim 27 recites a “computer program product” that includes code. Giving claim 27 the broadest reasonable construction, we find that claim 27 encompasses a computer program per se. Further, we find that claim 27 also encompasses the computer program product being embodied on a carrier wave, since claim 27 recites the open transitional phrase “comprising” and does not preclude the computer program product from being embodied in a carrier wave³. A computer program per se is not directed to one of the four categories of patent-eligible subject matter.⁴ Also, a signal (*i.e.* “a computer program product embodied in a carrier wave”) does not fit within at least one of the four statutory subject matter categories under 35 U.S.C. § 101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007). Since claim 27, as we have construed it above, encompasses both a computer program per se and a

³ See U.S. Patent & Trademark Office, Subject Matter Eligibility of Computer Readable Media, Jan. 26, 2010, available at <http://www.uspto.gov/web/offices/com/sol/og/2010/week08/TOC.htm#ref2>.

⁴ See U.S. Patent & Trademark Office, Interim Examination Instructions for Evaluating Subject Matter Eligibility under 35 U.S.C. § 101, Aug. 2009, at 2, available at http://www.uspto.gov/patents/law/comments/2009-08-25_interim_101_instructions.pdf.

signal, we find claims 27, and claim 38, dependent thereon, are directed to non-statutory subject matter.

CONCLUSIONS OF LAW

We conclude that the Appellants have overcome the prima facie showing of anticipation with respect to the rejection of claims 17, 18, 25-27, 34, 36, and 38 under 35 U.S.C. § 102(b) as anticipated by Call and have overcome the prima facie showing of obviousness with respect to the rejection of claims 17, 18, 25-27, 34, 36, and 38 under 35 U.S.C. § 103(a) as unpatentable over Call and Tobin.

We enter a new ground of rejection on claims 27 and 38 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

DECISION

The decision of the Examiner to reject claims 17, 18, 25-27, 34, 36, and 38 is reversed.

We enter a new ground of rejection on claims 27 and 38 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise

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one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

REVERSED; 37 C.F.R. § 41.50(b)

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